

REMARKS

Paragraphs [0008], [0026], and [0031] are amended to correct typographical errors. No new matter has been added.

Independent claims 1 and 15 are amended for purposes of expediting prosecution. Dependent claims 11, 12, 13, 14, 16, and 17 are amended for consistency with the base claims, and claims 5, 7-10, and 18-19 are cancelled without prejudice. New claim 20 is added to claim the invention in alternative language. New claim 20 is thought to be patentable over the prior art because it is an apparatus claim and includes all the functional limitations of claim 1, which is understood to be patentable over the prior art.

Example embodiments that illustrate and describe the added limitations may be found in the specification in paragraphs [0003], [0017], [0018], [0020]-[0023], [0025], and [0029].

Claims 1-4, 6, 11-17, and 20 remain, and reconsideration and allowance are respectfully requested.

The Office Action fails to establish that claims 1-19 are unpatentable under 35 USC §101 as claiming non-statutory subject matter. The rejection is respectfully traversed because the Office Action does not establish a *prima facie* case that the invention as a whole is directed solely to an abstract idea or to manipulation of abstract ideas or does not produce a useful result. The MPEP at §2106 II. A. provides the following guidance:

Although the courts have yet to define the terms useful, concrete, and tangible in the context of the practical application requirement for purposes of these guidelines, the following examples illustrate claimed inventions that have a practical application because they produce useful, concrete, and tangible result:

- Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held to be directed to patentable subject matter because "the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle." *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999);

- "[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm,

formula, or calculation, because it produces 'a useful, concrete and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601; and

- Claims drawn to a rasterizer for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means were held to be directed to patentable subject matter since the claims defined "a specific machine to produce a useful, concrete, and tangible result." *In re Alappat*, 33 F.3d 1526, 1544, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994).

A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

Based on the direction provided by the MPEP, the Office Action fails to present any evidence to show that claims 1 and 7 do not produce a useful, concrete, and tangible result. The claims recite limitations for generating design rules for use in validating an electronic design. Thus, the claims are directed to tangible steps for obtaining a useful result, and the Office Action fails to establish a *prima facie* showing that claims 1-19 are directed to abstract ideas. Based on the specific embodiments and the utilities of the invention disclosed in the complete specification, claims 1-19 are thought to be directed to statutory subject matter, and the rejection should be withdrawn.

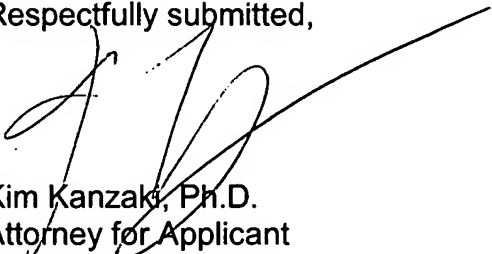
The rejection of claims 1-6 and 15-19 under 35 USC §112, first paragraph, as failing to comply with the written description requirement is respectfully traversed. The claim limitations are thought to be fully supported by the specification as set forth above. Therefore, the rejection of claims 1-6 and 15-19 under 35 USC §112 should be withdrawn.

The rejection of claims 1-19 under 35 USC §102(b) as being anticipated by "Kruglinski" (*Inside of Visual C++* to Kruglinski) is respectfully traversed because the Office Action does not show that all the limitations of the claims are taught by Kruglinski. However, the rejection is now moot in view of the amendments to the claims. Therefore, the rejection of claims 1-19 should be withdrawn.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

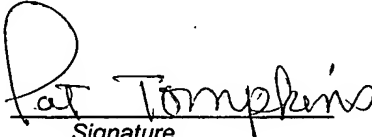
Respectfully submitted,



Kim Kanzaki, Ph.D.
Attorney for Applicant
Reg. No. 37,652

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on June 16, 2006.

Pat Tompkins
Name



Signature